

REMARKS

This Amendment and Response to Non-Final Office Action is being submitted in response to the non-final Office Action mailed December 10, 2004. Claims 1-34 were pending in the Application. Claims 1-15 and 16-34 are subject to an election/restriction requirement under 35 U.S.C. 121 and Claims 1-15 have been withdrawn from further consideration by Examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention. Claims 16-25 and 29-34 stand provisionally rejected under the judicially-created doctrine of obviousness-type double-patenting as being unpatentable over Claims 1-19 of co-pending U.S. Patent Application No. 10/417,991. Claims 16-25 and 29-34 also stand provisionally rejected under the judicially-created doctrine of obviousness-type double-patenting as being unpatentable over Claims 1, 2, 8, 10-14, and 16-21 of co-pending U.S. Patent Application No. 10/657,632. Claims 16-18, 20, 22-24, and 33 further stand rejected under 35 U.S.C. 102(e) as being anticipated by Lawandy et al. (U.S. Patent No. 6,531,262). Claim 32 still further stands rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. in view of Bakos et al. (U.S. Patent No. 6,537,635) and Claim 34 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. Finally, Claims 17-21 and 26-28 are objected to for containing references to structures which are present in the specification, but not, however, in the claims.

Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if the above-referenced objection is addressed.

In response to these objections and rejections, Claims 16, 20, 22, 23, 26, 27, and 28 have been amended to further clarify the subject matter which Applicants regard as their invention and Claims 17, 18, and 19 have been canceled. A Terminal Disclaimer and Statement Under 37 CFR 3.73(b) have also been prepared and these documents are

attached hereto. The amendments made herein are fully supported in the specification, drawings, and claims of the Application and no new matter has been added. Based upon the amendments, cancellations, Terminal Disclaimer, and Statement Under 37 CFR 3.73(b), reconsideration of the Application is respectfully requested in view of the following remarks.

Election/Restriction Requirement Under 35 U.S.C. 121:

Claims 1-15 (drawn to an adhesive composition, classified in class 524, subclass 379) and 16-34 (drawn to a limited play data storage medium, classified in class 428, subclass 64.4) are subject to an election/restriction requirement under 35 U.S.C. 121 and Claims 1-15 have been withdrawn from further consideration by Examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention.

Applicants hereby affirm this election, reserving the right to file an appropriate divisional application including claims drawn to the non-elected invention.

Objection to Claims 17-21 and 26-28:

Claims 17-21 and 26-28 are objected to for containing references to structures which are present in the specification, but not, however, in the claims.

In response to this objection, as well as to make other amendments possible, Claims 17 and 18, formerly containing references to structures VI and VII of the specification, have been canceled. Claims 19-21 and 26-28, not containing references to structures VI and VII of the specification, have either been canceled or, alternatively, amended to change their dependency.

Therefore, Applicants respectfully request that the objection to Claims 17-21 and 26-28 now be withdrawn.

Provisional Rejection of Claims 16-25 and 29-34 – Double-Patenting – 10/417,991:

Claims 16-25 and 29-34 stand provisionally rejected under the judicially-created doctrine of obviousness-type double-patenting as being unpatentable over Claims 1-19 of co-pending U.S. Patent Application No. 10/417,991. Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other. The present Application claims a substrate and at least one layer thereon, wherein the at least one layer comprises a reactive material and a photo-bleaching retarder. 10/417,991 claims a reactive material and at least one polyhydroxy compound. Although 10/417,991 does not claim a photo-bleaching retarder, Applicants define a photo-bleaching retarder in the specification as a polyhydroxy compound. Further, 10/417,991 does not specifically claim a substrate. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the composition of 10/417,991 to a substrate.

In response to this provisional rejection, Applicants submit that both the present Application and 10/417,991 are assigned to and owned by General Electric Company of Schenectady, NY. Accordingly, per the attached Terminal Disclaimer, General Electric Company hereby disclaims the terminal part of the statutory term of any patent granted on the Application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any Terminal Disclaimer, of any patent granted on 10/417,991. General Electric Company hereby agrees that any patent so granted on the Application shall be enforceable only for and during such period that it and the prior patent are commonly owned.

Therefore, Applicants respectfully request that the provisional double-patenting rejection of Claims 16-25 and 29-34 based on 10/417,991 now be withdrawn.

Provisional Rejection of Claims 16-25 and 29-34 – Double-Patenting – 10/657,632:

Claims 16-25 and 29-34 stand provisionally rejected under the judicially-created doctrine of obviousness-type double-patenting as being unpatentable over Claims 1, 2, 8, 10-14, and 16-21 of co-pending U.S. Patent Application No. 10/657,632. Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other. The present Application claims a substrate and at least one layer thereon, wherein the at least one layer comprises a reactive material and a photo-bleaching retarder. 10/657,632 claims a reactive material and at least one polyhydroxy compound. Although 10/657,632 does not claim a photo-bleaching retarder, Applicants define a photo-bleaching retarder in the specification as a polyhydroxy compound. Further, 10/657,632 does not specifically claim a substrate. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the composition of 10/657,632 to a substrate.

In response to this provisional rejection, Applicants submit that 10/657,632 was filed after the present Application and, therefore, is not a proper prior art reference. Thus, a terminal disclaimer is not warranted, absent evidence to the contrary presented by Examiner. The present Application was filed on August 1, 2003. 10/657,632 was filed on September 8, 2003, with no claim of priority to any earlier date.

Therefore, Applicants respectfully request that the provisional double-patenting rejection of Claims 16-25 and 29-34 based on 10/657,632 now be withdrawn.

Rejection of Claims 16-18, 20, 22-24, and 33 Under 35 U.S.C. 102(e):

Claims 16-18, 20, 22-24, and 33 stand rejected under 35 U.S.C. 102(e) as being anticipated by Lawandy et al. (U.S. Patent No. 6,531,262). Specifically, Examiner states that Lawandy et al. disclose a limited play data storage medium comprising at least one substrate, at least one reactive layer comprising at least one carrier material, at least one

reactive material disposed within the carrier material, and a photo-bleaching retarder material, more specifically polyhydroxystyrene, disposed within the carrier material (col. 17, lines 27-32).

In response to this rejection, Claim 16 has been amended to incorporate the elements/limitations of otherwise-unrejected (and now canceled) Claim 19:

16. A limited play data storage medium, comprising:

at least one substrate;

at least one of a reactive layer and a reactive adhesive layer disposed directly or indirectly adjacent to a surface of the substrate;

wherein, if used, the reactive layer comprises at least one carrier material, at least one reactive material disposed within the at least one carrier material and at least one photo-bleaching retarder material disposed within the at least one carrier material;

wherein, if used, the reactive adhesive layer comprises at least one adhesive material, at least one reactive material disposed within the at least one adhesive material and at least one photo-bleaching retarder material disposed within the at least one adhesive material; and

wherein the at least one photo-bleaching retarder material comprises a polyhydroxy compound selected from the group consisting of resorcinol, 4-hexylresorcinol, chlororesorcinol, an oxidation product of resorcinol and 2,4-dihydrobenzoic acid.

As Examiner has indicated, Lawandy et al. do not disclose using a photo-bleaching retarder material comprising a polyhydroxy compound such as resorcinol, 4-hexylresorcinol, chlororesorcinol, an oxidation product of resorcinol and 2,4-dihydrobenzoic acid.

Therefore, Applicants respectfully request that the rejection of Claims 16-18, 20, 22-24, and 33 under 35 U.S.C. 102(e) as being anticipated by Lawandy et al. now be withdrawn.

Rejection of Claims 32 and 34 Under 35 U.S.C. 103(a):

Claim 32 still further stands rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. in view of Bakos et al. (U.S. Patent No. 6,537,635) and Claim 34 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al.


In view of the argument related to Claim 16 above, and in view of the fact that Claims 32 and 34 are dependent from Claim 16, Applicants respectfully request that the rejection of Claims 32 and 34 under 35 U.S.C. 103(a) now be withdrawn.

CONCLUSION

Applicants would like to thank Examiner for the attention and consideration accorded the present Application. Should Examiner determine that any further action is necessary to place the Application in condition for allowance, Examiner is encouraged to contact undersigned Counsel at the telephone number, facsimile number, mailing address, or email address provided below. It is not believed that any fees for additional claims, extensions of time, or the like are required beyond those that may otherwise be indicated in the documents accompanying this paper, including the Terminal Disclaimer fee. However, if such additional fees are required, Examiner is encouraged to notify undersigned Counsel at Examiner's earliest convenience.

Respectfully submitted,

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